

data, the controller being configured to control the transmitter to transmit a plurality of synchronization bits preceding the user identification data; and

a receiver disposed within the communication device, the receiver configured to receive information transmitted via electromagnetic waves, wherein the receiver is specifically configured to receive user identification data transmitted from the remote access unit by recognizing and synchronizing to the synchronization bits.

### **REMARKS**

#### **Present Status of the Application**

The Office Action rejected all claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patents 5,221,838 to Gutman *et al.*. Applicant has amended independent claim 1, 12, and 14, and has added new claim 16. After entry of the foregoing amendments, claims 1-16 remain pending in the present application, and reconsideration of those claims is respectfully requested.

#### **Clarification of Claim Dependencies**

Applicant acknowledges the inadvertent inclusion of two claims each numbered 9, and the Examiner's renumbering of claims 9-14 (beginning with the second claim 9) as claims 10-15 respectively. Applicant wishes to confirm that the dependency of each of the newly-numbered claims should be incremented accordingly. Thus, new claims 10 and 11 each depend from claim 9, and claim 13 depends from claim 12.

Summary of Applicant's Invention

The present invention is generally directed to a system for providing the transmission of user identification (*e.g.*, account/billing information) to a communicating device, such as a telephone. In accordance with one aspect of the invention, the system includes a telephone, and receiving means provided at the telephone for receiving data transmitted via a electromagnetic waves. Although not necessary for the invention, in a preferred the telephone includes a card reader for receiving and reading magnetically encoded cards. In this embodiment, the receiving means is operatively and electrically connected to the magnetic card reader, so as to allow the system to operate either by access from a remote transmitter or by way of an inserted card. The system of the invention further includes a remote access unit having a memory configured to store user identification data and a low-power transmitter adapted to transmit the user identification data to the receiving means. The remote access unit is manually operated by a transmit button, which, when depressed, causes a controller to retrieve user identification data from the memory and transmit the user identification data from the low-power transmitter.

In accordance with the broad aspect of the invention, the system communicates information to a communicating device, such as a telephone. However, the device could more broadly be a computer/modem, an ISDN converter, a cable box, *etc.* For example, a computer user dialing out to a remote, or long distance location, may supply the modem with the calling card number for billing simply by pressing the transmit button. In similar fashion, billing information may be communicated to a cable box. Recent technology developments are

expanding the use of cable services, and two-way interactive cable services are rapidly approaching. In such uses, depending upon the application, it may be desirable to transmit billing or account information from a customer premise. A transmitter, constructed in accordance with the invention, may be used provide this capability.

#### Discussion of Office Action Rejections

The Office Action rejected all claims 1-15 as being unpatentable over U.S. Patent 5,221,838 to Gutman *et al.* There is at least one fundamental distinction between the Applicant's invention and the Gutman reference; namely, Applicant's invention is directed to a low-power RF transmitter ("remote access unit") that communicates financial information to a nearby communication device, such as a telephone. The essence of the Applicant's invention is the ability to communicate personal financial information and user identification information via a low-power RF, electromagnetic link to a nearby communication device, which can then relay the information to a financial institution, via PSTN, cellular link, or other appropriate telecommunication link.

The Gutman reference wholly fails to teach this inventive essence, as there is no low-power or RF communication link taught or otherwise disclosed by that reference. Instead, Gutman appears to disclose the communication of financial information from an "electronic wallet" to a financial institution. To better appreciate the Applicant's invention, in relation to the Gutman reference, the Applicant's invention could be utilized to communicate financial information to the electronic wallet of Gutman (assuming the electronic wallet was configured to include an RF receiver), which could then relay this information to a financial institution.

As will be more fully discussed below, this fundamental limitation is present in each of the independent claims, and is more specifically discussed below.

Independent Claim 1

Applicant respectfully traverses the rejection made to independent claim 1. Among other features, claim 1 specifically claims "receiving means ...". This claim element, therefore, is a means plus function element, and must therefore be construed in accordance with 35 U.S.C. § 112, sixth paragraph. Specifically, this element must be construed to cover only the structure specifically disclosed in the specification and the equivalents thereof. In this regard, Applicant hereby invokes the claim construction mandate set forth in the case of *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(*en banc*).

Specifically, *In re Donaldson* provides that "[T]he plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(*en banc*). "The broadest reasonable interpretation that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson* at 1194-1195.

The "receiving means" is disclosed as a RF receiver (reference numeral 50 of FIG. 2). In contrast, the Office Action has stated that

Gutman discloses a system for transmitting billing information to a communication device comprising: receiving means (512) operatively associated with a communication device for receiving data (fig. 5B), and a remote access device (510) ...

Applicant respectfully traverses this rejection.

FIG. 5B of Gutman discloses the electronic wallet 510 of that invention, in communication with a "Financial Institution" (reference numeral 512). The Office Action has cited the Financial Institution as teaching the "receiving means" of the claimed invention. As noted above, however, the receiving means of the present invention is a RF receiver, that is configured to receive electromagnetic waves from an RF transmitter. Therefore, the rejection is misplaced.

In addition, claim 1 specifies that the receiving means is configured to receive data transmitted via electromagnetic waves. There is no such teaching within Gutman. Thus, Applicant respectfully submits that the Gutman reference has been misapplied, in the context of the present invention.

Furthermore, Applicant submits that, as applied, Gutman fails to disclose the "communication device" of the claimed invention. As set forth in the present specification (*e.g.*, page 7, lines 15-19), the communication device of the present invention is a device capable of communicating across a telecommunication link, such as the PSTN or even a cellular link. The "communication device" limitation is present in both the preamble, as well as the body of claim 1, and therefore cannot be ignored. To further the proper

interpretation of this claim feature, Applicant references dependent claim 8, which depends from claim 1 and specifies that the communication device is either a telephone, a modem, an ISDN (integrated services digital network) converter, or a cable converter box. Well established rules of claim construction dictate that the scope of an independent claim (*i.e.*, claim 1) must be construed in light of other claims. Therefore, this basic canon of claim construction, along with the Doctrine of Claim Differentiation, requires that the communication device, as set forth in claim 1 be so construed. If the Patent Office construes the "Financial Institution" as comprising the "communication device", then it must cite an additional appropriate teaching of an RF receiver within the Financial Institution.

Applicant submits that a person of ordinary skill in the art would interpret the teachings of Gutman, and particularly Fig. 5B therein, as defining a telecommunication link (such as a PSTN link, or a network connection) between the electronic wallet 510 and the Financial Institution 512. This link would not be construed as an electromagnetic link, as claimed by the present invention.

Indeed, the essence of the present invention is the communication of financial information to a communication device, which would then relay this information to a Financial Institution. By analogy, the electronic wallet of the Gutman reference would be analogous to the communication device of the claimed invention. Gutman fails to teach, however, the remote access unit of the present invention. To further define the remote access unit, claim 1 has been amended above to specify that the remote access unit includes a low-power RF transmitter for transmitting the data to the communication device.

In light of these various features, in addition to the general nature of the Applicant's invention, Applicant respectfully submits that independent claim 1 and dependent claims 2-8 patently define over the Gutman reference.

Independent Claim 9

Among other limitations, independent claim 9 specifically defines the step of "transmitting a low-power electromagnetic signal including the formatted user identification information." This element is wholly absent from the Gutman reference. Accordingly, for at least this reason, independent claim 9 and dependent claims 10-11 patently define over Gutman, and are in condition for allowance.

Independent Claim 12

Claim 12 is similar to claim 1, but specifically claims the communication device, in the body of the claim. In this regard, claim 12 defines:

12. *A system for providing remote access to a communication device, comprising:*
- a communication device;*
  - a receiver associated with the communication device and configured to receive data transmitted via a electromagnetic waves;*
  - a remote access unit having a memory configured to store user identification data and a low-power transmitter further including a transmitter adapted to transmit the user identification data to the receiver via electromagnetic waves, the remote access unit further having a manually-operated transmit button and a controller responsive to the transmit button to controllably retrieve user identification data from the memory and transmit the user identification data from the low-power transmitter.*

*(Underlined material added by way of foregoing amendment.)* Among other differences, Gutman fails to disclose "a receiver ... configured to receive data transmitted via electromagnetic waves" or a "remote access unit ... further including a radio frequency (RF) transmitter adapted to transmit the user identification data to the receiver via electromagnetic waves ..."

The Gutman reference has been applied to this claim by alleging that the Financial Institution 512 is a receiver. As previously discussed, Applicant respectfully submits that this rejection is misplaced. Gutman could be more appropriately applied by analogizing the electronic wallet of Gutman to the claimed communication device. Even applying Gutman in such a manner, however, fails to properly render the present application unpatentable, as Gutman fails to disclose the low-power RF transmitter or the corresponding RF receiver.

Applicant has amended independent claim 12 (previously numbered claim 11), to further clarify these features. Accordingly, and for at least these reasons, independent claim 12 and dependent claim 13 patently define over Gutman.

Independent Claims 14 and 15

Independent claim 14 (previously claim 13) closely parallels claim 12, and patently defines over Gutman for the same reasons advanced with respect to claim 12. Claim 14 has been amended herein to further clarify certain transmitter features of the present invention.



Independent claim 15 closely parallel independent claim 9, and patently defines over Gutman for the same reasons advanced with respect to claim 9.

Newly Added Claim 16

Applicant has added new claim 16, which Applicant submits patently defines over the prior art of record.

Prior Art Made of Record

The undersigned acknowledges U.S. Patents 5,550,358 to Tait *et al.*, 5,468,948 to Koenck *et al.*, and 4,967,366 to Kaehler have been made of record but not relied upon. The undersigned has reviewed each of these references, and respectfully submits that the presently claimed invention patently defines over each of these references.

Amendments Have Not Necessitated New Grounds for Rejection

The undersigned wishes to note that the claim features clarified by the above-amendments have not changed the substantive scope of the claims, but rather have been made for purposes of clarification. Indeed, independent claim 9 has not been amended at all. Accordingly, any new rejections made on prior art (other than the Gutman reference) have not been necessitated by the claim amendments, but rather the arguments set forth herein. Therefore, any subsequent Office Action raising such future should be a non-FINAL action.

**CONCLUSION**

In view of the foregoing, Applicant respectfully submits that all claims 1-16 are in proper condition for allowance, and the Examiner is respectfully requested to pass this case to issuance.

If, in the opinion of the Examiner a teleconference would expedite the processing of the present application, then the Examiner is invited to contact the undersigned.

Respectfully Submitted,

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